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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/284,699	04/19/1999	YASUSHI TANAKA	450108-4542	2687

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FROMMER LAWRENCE & HAUG  
745 FIFTH AVENUE- 10TH FL.  
NEW YORK, NY 10151

EXAMINER
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SALCE, JASON P

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2623

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/284,699	<b>Applicant(s)</b> TANAKA, YASUSHI	
	<b>Examiner</b> Jason P. Salce	<b>Art Unit</b> 2623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11 April 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-11, 14-35 and 37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11, 14-35 and 37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### ***Response to Arguments***

Applicant's arguments filed 4/11/2008 have been fully considered but they are not persuasive.

Applicant has traversed the 112 1<sup>st</sup> Paragraph rejection, however the arguments are not persuasive. Applicant cites Paragraph's 0125 and 0128, which states that the CM of the sponsor providing a program. The examiner notes that although these sections clearly states that the CM of the sponsor provides a program, the claims recite that, "each of said commercial information of the **commercial information** sponsor of the program". Clearly the specification fails to support a commercial information sponsor. The examiner recommends amending the claims to recite, "each of said commercial information of the sponsor of the program".

The examiner notes that another 112 1<sup>st</sup> Paragraph has risen based on the claim limitations, "selectively picking program content data from a plurality of program content regions and combining the selectively picked program content data from said plurality of program content regions with transmitted screen layout data and previously stored standard screen layout data to create said program guide screen". The examiner notes that these limitations are taught by Figure 11 and Paragraphs 0096-0104. The claims specify that previously stored standard screen layout data and transmitted screen layout data are used to create a program guide screen. While Figure 11 and Paragraphs 0096-0104 teach using layout data to create a program guide screen, the only layout

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data used in these portions of the specification is  $D_{ML}$ . The only other reference to any other type of layout data is the layout data  $D_o$ , however,  $D_o$  is not described anywhere else in the specification, nor does the specification at Paragraph 0104 teach that layout data  $D_o$  is either transmitted or previously stored. Therefore, the specification fails to teach using transmitted and previously stored layout data to form an EPG screen.

The examiner further notes that based on the amendments made to the claims, that the claims again read on the Schein reference previously used to reject the claims **(see rejection below)**.

### ***Election/Restrictions***

This application contains claim 36 drawn to an invention nonelected without traverse in the reply filed on 10/30/2007. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

### ***Drawings***

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description:  $D_o$  disclosed in Paragraph 0104. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply

to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-11 and 14-35 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Applicant has traversed the 112 1<sup>st</sup> Paragraph rejection, however the arguments are not persuasive. Applicant cites Paragraph's 0125 and 0128, which states that the CM of the sponsor providing a program. The examiner notes that although these sections clearly states that the CM of the sponsor provides a program, the claims recite

that, "each of said commercial information of the **commercial information** sponsor of the program". Clearly the specification fails to support a commercial information sponsor. The examiner recommends amending the claims to recite, "each of said commercial information of the sponsor of the program".

The examiner notes that another 112 1<sup>st</sup> Paragraph has risen based on the claim limitations, "selectively picking program content data from a plurality of program content regions and combining the selectively picked program content data from said plurality of program content regions with transmitted screen layout data and previously stored standard screen layout data to create said program guide screen". The examiner notes that these limitations are taught by Figure 11 and Paragraphs 0096-0104. The claims specify that previously stored standard screen layout data and transmitted screen layout data are used to create a program guide screen. While Figure 11 and Paragraphs 0096-0104 teach using layout data to create a program guide screen, the only layout data used in these portions of the specification is D<sub>ML</sub>. The only other reference to any other type of layout data is the layout data D<sub>o</sub>, however, D<sub>o</sub> is not described anywhere else in the specification, nor does the specification at Paragraph 0104 teach that layout data D<sub>o</sub> is either transmitted or previously stored. Therefore, the specification fails to teach using transmitted and previously stored layout data to form an EPG screen.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-11, 14-35 and 37 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Schein et al. (U.S. Patent No. 6,002,394).

Referring to claim 1, Schein discloses an information transmitting method for transmitting program guide information (**see Column 7, Lines 36-45**) and processing commercial information which corresponds to said program guide information and which is automatically displayed for a single program column and is transmitted together with said program guide information (**see Column 7, Lines 35-45 for transmitting commands in the VBI, which are used to create an EPG, and also note Column 8, Lines 3-7 for also transmitting commands which contain URL information which allows a user to access a linked internet site from the EPG**).

Schein also discloses that when a cursor is moved onto a program of a program column of the program guide screen (**see Column 21, Lines 38-41 for navigating through a program guide screen and note Figure 20A for selecting the WORLD OF SERVICES menu or Figure 20B for selecting a program column that contains further commercial information, such as commercial information in window 528, ticker 524**), each of said commercial information of the sponsor of the program (**see**

**again Figures 20A and 20B and Column 22, Lines 3-18 for displaying contextual video or graphics related to the program in the program guide that has been highlighted)** is displayed successively, shifted temporally from one another (**see Figure 20C for displaying the commercial information on the same screen and in different regions from one another**).

Schein also discloses selectively picking program content data from a plurality of program content regions to create said program guide screen (**see Column 10, Lines 40-59 for the user keeping a favorite channel list, selectable by the user and Figure 20A for the user being able to select his/her favorite channels from a program guide screen and Figure 21B for adding channel to the favorite list**).

Schein also discloses combining the selectively picked program content data from said plurality of program content regions with transmitted screen layout data and previously stored standard screen layout data to create said program guide screen (**see Column 7, Lines 16-38 and Column 9, Lines 1-5 and 56-61 and Column 12, Lines 5-10 and 47-60**).

Schein also discloses that the program content data includes three types of data, modifiable broadcast data (**see modifiable favorite channel database at Column 10, Lines 40-59**), fixed broadcast data (**see Figure 7B**) and comparatively large-sized broadcast data (**see Figure 5**).

Schein also discloses that the selectively picked program content data are categorized in at least two types of data with different structures and formats (**see Column 10, Lines 40-67, where programs can be selected not only by favorite**



**channel listings (see Figure 19A) but also setting reminders for the programs or restricting access to programs, therefore categorizing the content data in at least two types of data with different structures and formats).**

Schein also discloses that the commercial information includes a remote network server address information **(see Column 18, Lines 20-67 and Column 20, Lines 1-17 and Column 23, Line 37 through Column 24, Line 60).**

Referring to claim 2, Schein discloses that the commercial information contains image data (Column 11, Lines 56-57).

Referring to claim 3, Schein discloses that a digital signal can have separate bitstreams that contain video, audio, and program guide information (Column 6, Lines 51-60), and that data related to a television program guide title is related to an advertisement (see the rejection of claim 1 and note that the advertisement shown in window 528 is related to the television program selected in the program matrix 506).

Referring to claim 4, Schein discloses that commercial information can be accessed on a remote computer via the Internet (Column 20, Lines 4-9), and that a computer on a computer network (Internet) can be given an IP address (Column 18, Lines 20-43).

Referring to claim 5, Schein discloses hierarchical levels for program schedule data (Column 9, Lines 20-67 and Column 10, Lines 1-28) for a program guide, which contains advertisements (Column 22, 10-18). Schein shows that a first hierarchical level (Channel Data Table) is smaller by holding only the channel required for viewing at a specific subscriber's receiver, while the second hierarchical level (show list) contains start times and additional scheduling data for 24 hours worth of program for every channel listed in the Channel Data Table (Column 9, Lines 20-62 and Figures 5 and 6). It is inherent that the Channel Data Table is smaller than the Show List Table because of the large amount of data storage that would be required to hold 24 hours or weeks worth of show times for each program contained in the Channel Data Table.

Referring to claim 6, see the rejection of claim 1 and note that Schein further discloses a receiver for separating program guide information from a received broadcasting signal (Column 12, Lines 41-44).

Schein also further discloses a processor (see Figure 3) for displaying commercial information in a part of a display area (see Figure 21A and Column 24, Lines 1-20), and an electronic program guide screen including program columns corresponding to a plurality of programs based on the separated program guide information (see Figure 21A).

Schein also further discloses that the processor (Figure 3) processes commercial information which corresponds to said program guide information and which is automatically displayed for a single program column and is transmitted together with

said program guide information (see Column 7, Lines 35-45 for transmitting commands in the VBI, which are used to create an EPG, and also note Column 8, Lines 3-7 for also transmitting commands which contain URL information which allows a user to access a linked internet site from the EPG).

Referring to claim 7, Schein discloses specifying commercial information displayed on part of said program guide screen (see Figure 21A).

Schein also discloses communicating with an external computer through a computer network (Column 20, Lines 4-9).

Schein also discloses displaying further detailed information from an external computer based on address information to display the information when a cursor is moved onto one of the program columns (Figures 21B and 21C and Column 18, Lines 20-43 and Column 19, Lines 51-63).

Referring to claim 8, Schein discloses selecting a program column on a program guide, and displaying program details corresponding to the program column selected and to sequentially display plural items of commercial information included in the program in a part of the display area (see Figures 21A, 21B, and 21C and Column 24, Lines 1-19).

Referring to claim 9, Schein discloses displaying a commercial details screen (see top left window explaining NFL cap in Figure 21C).

Referring to claim 10, see rejection of claim 9.

Referring to claim 11, Schein discloses sponsors for presenting commercial information (Column 22, Lines 10-18).

Referring to claim 14, see rejection of claim 2.

Referring to claim 15, see rejection of claim 3.

Referring to claim 16, see rejection of claim 6.

Referring to claims 17-21, see rejections of claims 8-12, respectively.

Referring to claim 22, see rejection of claims 1, 6 and 16. Also note Figure 1 for a transmitting apparatus.

Referring to claims 23-24, see rejection of claims 20-21, respectively.

Referring to claims 25-26, see rejection of claims 25-26, respectively.

Referring to claim 27, see rejection of claim 6.

Referring to claims 28-30, see rejection of claim 27.

Referring to claims 31-34, see the rejection of claims 1, 6, 16 and 22.

Referring to claim 35, see the rejection of claim 1.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 37 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schein et al. (U.S. Patent No. 6,002,394) in view of Hendricks et al. (U.S. Patent No. 6,052,554).

Referring to claim 37, Schein discloses all of the limitations of claim 34, but fails to teach the limitations of claim 37.

Hendricks discloses an output management data producer to provide management information for a plurality of programs in the EPG including program broadcast time (**see Column 6, Line 66 through Column 7, Lines 24**).

Hendricks also discloses an EPG editor to receive the management information and commercial information and to provide EPG data (**see Column 7, Lines 25-46**).

Hendricks also discloses a multiplexer to combine encoded audio/visual program data synchronized with the EPG data and produce an EPG transmission signal for transmission (**see Column 8, Lines 23-35**).

Hendricks also discloses that the EPG data has program content data on the programs of each broadcasting channel during a predetermined time interval ( ) that hierarchically includes broadcasting form data for regular program, group data that is common in a plurality of programs of the broadcasting form data arranged as a single program, and detailed contents data including respective programs of the broadcast

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form data and the particular information group data (**see Column 21, Line 1 through Column 23, Line 25**).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art, to modify the television program transmission system, as taught by, Schein, using the program packaging and delivery system, as taught by Hendricks, for the purpose of a system capable of packaging hundreds of television programs for delivery to subscribers (**see Column 4, Lines 35-37 of Hendricks**).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason P. Salce whose telephone number is (571) 272-7301. The examiner can normally be reached on M-F 9am-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Miller can be reached on (571) 272-7353. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jason P Salce/  
Primary Examiner, Art Unit 2623

Jason P Salce  
Primary Examiner  
Art Unit 2623

July 1, 2008